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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/31/2000

Mark J. Hahn

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919

7590

07/15/2004

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EXAMINER

YUSSUF, SAJID

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/652,908

Applicant(s)

HAHN ET AL.

Examiner

Sajid A Yussuf

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2000 and 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- a. A person shall be entitled to a patent unless –

- b. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. ***Claim(s) 1-7, 9-16, 18-22, 25-30 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Birrell et al. (US Patent No. 6,185,551 and Birrell hereinafter).***

5. As per claim(s) 1,9,10,18 Birrell discloses a user profile (i.e., account manager) configured to store user preferences for processing messages, (See Column 5 Lines 29-48) a message filter configured to receive one, or more messages, (See Column 4 Lines 15-20) perform in-band processing (i.e., parsing) on the message, (See Column 7 Lines 23-55) based on the user preferences (i.e., user defined labels), (See Column 8 Lines 42-48) and generate at least one event (i.e., outputting, displaying, or printing), (See Column 9 Lines 25-40), for triggering out of-band processing (i.e., removing the unread label) of the message, (See Column 9 Lines 25-40); and at

least one external helper (i.e., account manager) configured to perform the out-of-band processing (i.e., label state) of the messages in response to the at least one event (i.e., outputting, displaying, or printing), (See Column 5 Lines 29-40 & Column 9 Lines 25-40).

6. As per claim(s) 2,11,19 Birrell teaches the claimed invention as described in claim(s) 1,10,18 above and furthermore discloses a message manager (i.e., mail system) configured to examine the message and modify (i.e., filter), (See Column 4 Lines 15-20) the message based on the user preferences, (See Column 5 Lines 29-48) and an event manager (i.e., mail system) configured to send the at least one event (i.e., send mail, receive mail, query index, add/remove label to/from mail) to the at least one external helper (i.e., account manager) to trigger the out-of-band processing (i.e., label state), (See Column 4 Lines 60-67 and Column 5 Lines 1-19).

7. As per claim(s) 3,12 Birrell teaches the claimed invention as described in claim(s) 1-2 & 10-11 above and furthermore discloses a tokenizer (i.e., index server or indexer) configured to read the message and reduce the message (i.e., processed in batches) to a set of tokens (i.e., words), (See Column 7 Lines 23-45).

8. As per claim(s) 4,13,20 Birrell teaches the claimed invention as described in claim(s) 1-3, 10-12, and 18-19 above and furthermore discloses a plurality of message components (i.e., header and body) corresponding to elements of the message, (See Column 9 Lines 12-15) each of the message components being configured to recognize a specific portion of the message, (See Column 9 Lines 10-16 & Column 12 Lines 25-29) and modify the specific portion (i.e., appearance and functioning) based on the user preferences, (See Column 5 Lines 60-67).

9. As per claim(s) 5,14 Birrell teaches the claimed invention as described in claim(s) 1-4 & 10-13 above and furthermore discloses a header component configured to process a header portion of the message, (See Column 9 Lines 10-16) a separator component; (i.e., wherein the separator component is interpreted as a line/marking which separates the header from the body) configured

to process a separator portion of the message, (See Figure 7) And a body component configured to process a body portion of the message, (See Column 9 Lines 10-16).

10. As per claim(s) 6,15 Birrell teaches the claimed invention as described in claim(s) 1-5 & 10-14 above and furthermore discloses the message filter (filter queries) is further configured to generate an enhanced message from the in-band processing (i.e., queries) and transmit the enhanced message, (See Column 5 Lines 29-67) for delivery to one or more mailboxes associated with one or more message recipients, (i.e., users), (See Column 5 Lines 29-48).

11. As per claim(s) 7,16 Birrell teaches the claimed invention as described in claim(s) 1-6 & 10-15 above and furthermore discloses at least one external helper (i.e., account manager) is configured to further process (i.e., change label state) the message after delivery to the one or more mailboxes (See Column 5 Lines 29-40 & Column 9 Lines 25-40).

12. As per claim(s) 21 Birrell teaches the claimed invention as described in claim(s) 18-20 above and furthermore discloses instructions for processing (i.e., labeling the message) the processed message after providing the processed message for delivery to the message recipient (i.e., user), (See Column 9 Lines 17-24).

13. As per claim(s) 22,26 Birrell discloses a server configured to receive an e-mail message from an e-mail sender and destined for one or more e-mail recipients (i.e., users) (See Column 5 Lines 7-11), a personal messaging agent, (i.e., mail system) configured to receive the e-mail message from the server, (See Column 6 Lines 11-27) process the e-mail message based on preferences of the one or more e-mail recipients (i.e., users), (See Column 5 Lines 29-48) to create (i.e., parse) a processed e-mail message and output (i.e., access) the processed e-mail message, (See Column 5 Lines 40-67) and a local delivery agent (i.e., mail server) configured to receive the processed e-mail message, (See Column 5 Lines 13-15) and store the processed e-mail message in one or more mailboxes (i.e., pop-3) associated with the one or more e-mail recipients, (i.e., user), (See Column 5 Lines 30-40); and a

message retrieval system configured to retrieve the processed e-mail message, (See Column 5 Lines 7-11) from the one or more mailboxes and deliver the processed email message to the one or more e-mail recipients, (See Column 5 Lines 40-67).

14. As per claim(s) 25,27 Birrell teaches the claimed invention as described in claim(s) 22-24 & 26 above and furthermore discloses the personal messaging agent is configured to further process (i.e., label) the processed e-mail message after the local delivery agent (i.e., mail server) stores the processed e-mail message in the one or more mailboxes (See Column 5 Lines 30-40 & Column 9 Lines 16-24).

15. As per claim(s) 28 Birrell teaches the claimed invention as described in claim(s) 26-27 above and furthermore discloses personal messaging agent is configured to separate the processing of the e-mail message into in-band (i.e., parsing) (See Column 7 Lines 20-39) and out-of-band processing (i.e., label state) (See Column 9 Lines 25-40); wherein the separation occurs when multiple components are given different tasks such as that of parsing (i.e., using an index server) and label state management (i.e., account manager), (See Column 5 Lines 1-6)

16. As per claim(s) 29 Birrell discloses storing e-mail processing preferences (i.e., user preferences) (See Column 5 Lines 29-48) for one or more e-mail recipients, receiving an e-mail message from an e-mail sender and destined for one or more of the e-mail recipients (i.e., users) (See Column 5 Lines 7-11); processing the e-mail message based on the e-mail processing preferences (i.e., user preferences) and providing recipients the processed e-mail message for delivery to the one or more e-mail recipients (See Column 5 Lines 40-67).

17. As per claim(s) 30 Birrell discloses a user profile configured to store user preferences (See Column 5 Lines 29-48) of a message recipient for processing a message (i.e., sending, receiving), (See Column 5 Lines 7-11) and a message filter configured to receive a message destined for the message recipient, (See Column 5 Lines 32-36 and Column 5 Lines 55-67) process the message

based on the user preferences (i.e., named query) to produce a processed message, and deliver (i.e., access) the processed message to the message recipient, (See Column 5 Lines 40-67).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

c. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- d. Determining the scope and contents of the prior art.
- e. Ascertaining the differences between the prior art and the claims at issue.
- f. Resolving the level of ordinary skill in the pertinent art.
- g. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**20. Claim(s) 8,17,23,24 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell et al. (US Patent No. 6,185,551 and Birrell hereinafter) in view of Maurille (US Patent No. 6,484,196 and Maurille hereinafter).**

21. As per claim(s) 8,17 Birrell discloses the claimed invention as described above.

However, Birrell does not explicitly teach at least one external helper is configured to at least one of automatically generate a reply to the message, deliver the message to one or more alternate mailboxes, and notify the one or more message recipients of the delivery of the message.

Maurille teaches at least one external helper (i.e., message table) is configured to at least one of automatically generate a reply to the message, deliver the message to one or more alternate mailboxes, and notify the one or more message recipients of the delivery of the message (See Maurille Column 8 Lines 55-65).



Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Birrell with the teachings of Maurille to include a at least one external helper is configured to at least one of automatically generate a reply to the message, deliver the message to one or more alternate mailboxes, and notify the one or more message recipients of the delivery of the message with the motivation to provide for features and/or combination of features... in particular, a communication board system with multiple modes in which the communication board system can be variously configured as: a threaded mail system (See Maurille Column 2 Lines 52-67 and Column 3 Line 1).

22. As per claim(s) 23 Birrell discloses the claimed invention as described above.

However, Birrell does not explicitly teach the local delivery agent is further configured to generate status messages that indicate whether the deliveries of the modified message streams were successful.

Maurille teaches the local delivery agent is further configured to generate status messages that indicate whether the deliveries of the modified message streams were successful (i.e., acked), (See Maurille Column 8 Lines 53-55).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Birrell with the teachings of Maurille to include a local delivery agent is further configured to generate status messages that indicate whether the deliveries of the modified message streams were successful with the motivation to provide for features and/or combination of features... in particular, a communication board system with multiple modes in which the communication board system can be variously configured as: a threaded mail system (See Maurille Column 2 Lines 52-67 and Column 3 Line 1).

23. As per claim(s) 24 Birrell discloses the claimed invention as described above.

However, Birrell does not explicitly teach personal messaging agents are further configured to receive the status messages from the local delivery agent and provide the status messages to the server.

Maurille teaches personal messaging agents are further configured to receive the status messages from the local delivery agent and provide the status messages to the server, (See Maurille Column 3 Lines 15-27).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Birrell with the teachings of Maurille to include personal messaging agents are further configured to receive the status messages from the local delivery agent and provide the status messages to the server with the motivation to provide for features and/or combination of features... in particular, a communication board system with multiple modes in which the communication board system can be variously configured as: a threaded mail system (See Maurille Column 2 Lines 52-67 and Column 3 Line 1).

#### ***Response to Amendments***

24. Birrell et al. does not disclose or suggest a message filter that is configured to, among other things, generate at least one event for triggering out-of-band processing of a message based on user preferences for processing messages. The Examiner alleged that Birrell et al. discloses generating at least one event for triggering out-of-band processing of a message and cited column 9, lines 25-40, of Birrell et al. for support (Office Action, page 2).

25. Examiner disagrees as Birrell teaches of triggering out-of-band processing of a message based on user preference for processing messages wherein out-of-band processing can be interpreted as any processing that is executed external to a system which is designed for example to send and receive messages. Specifically, the reference discloses a method for sending and receiving mail messages based on user preferences where the sending and receiving part is interpreted as an in-band processing and send the message to be printed is in contrast interpreted as an out-of-band processing. The Examiner asks the Applicants to pay close attention to column 9, lines 25-40 where the reference teaches of printing a message.

26. The Examiner alleged that the outputting, displaying, or printing disclosed by Birrell et al. is equivalent to the claimed generating at least one event (Office Action, page 2). Applicants respectfully disagree. Birrell et al. does not disclose or suggest that the outputting, displaying, or printing of a message by a user is an event that triggers out-of-band processing of the message based on user preferences for processing messages stored in a user profile, as required by amended claim 1.

27. Examiner disagrees as an event is defined as an action or occurrence, often generated by user to which a program might respond, furthermore, Birrell teaches of an event that triggers out-of-band processing (i.e., printing) wherein the event can inherently be the user pressing an input where a software will recognize whether the user has executed the user settings for example pressing the print button to send the message to the printer thus resulting in out-of-band processing.

28. The Examiner also alleged that removing an unread label disclosed by Birrell et al. is equivalent to the claimed triggering out-of-band processing (Office Action, page 2). Applicants again disagree. Birrell et al. does not disclose or suggest that removing an unread label associated with a message when the message is outputted, displayed, or printed is based on user preferences for processing messages stored in a user profile, as required by amended claim 1.

29. Examiner disagrees as a user profile is interpreted broadly as a users mailbox, and furthermore user preferences can be a myriad of functions that customize & personalize users mailing experience wherein even changing users font or size or even the type of messages being send and received (i.e., plain text, HTML, Encoded) are all based on user preferences. Therefore outputting, displaying or printing is all based on user preferences that depict the users likes and dislikes based on appearance or print formatting for that matter.

30. In this section, Birrell et al, discloses that a message includes a header and a body. Nowhere in this section, or elsewhere, however, does Birrell et al. disclose or suggest a message manager that includes a plurality of message components corresponding to elements of the message, where each of the message components is configured to recognize a specific portion of the message and modify the specific portion based on the user preferences as recited in claim 4.

31. Examiner disagrees as the message manager inherently exists to provide oversight to recognize a "specific portion of the message," (i.e., body or header) wherein the elements are interpreted as the body and header of the e-mail message. Furthermore, the header portion contains addressing information, which is vital to ensure message delivery, and therefore requires certain components to deliver the message. Furthermore, user preferences are user to filter certain messages coming into users mailboxes.

32. At column 12, lines 25-29, Birrell et al. discloses: It should be noted, headers in Internet messages, depending on routing, can be quite lengthy. Therefore, it is possible to restrict the view to just the "from," "to," "cc," "date," and "subject" fields of the header. In this section, Birrell et al. discloses that the header fields presented to the user may be restricted to the "from," "to," "cc," "date," and "subject" fields. Nowhere in this section, or elsewhere, however, does Birrell et al. disclose or suggest a message manager that includes a plurality of message components corresponding to elements of the message, where each of the message components is configured to recognize a specific portion of the message and modify the specific portion based on the user preferences, as recited in claim 4.

33. Examiner disagrees as the message manager inherently exists to provide oversight to recognize a "specific portion of the message," (i.e., body or header) wherein the elements are interpreted as the body and header of the e-mail message. Furthermore, the header portion contains addressing information, which is vital to ensure message delivery, and therefore requires certain

components to deliver the message. Furthermore, user preferences are user to filter certain messages coming into users mailboxes.

34. In this section, Birrell et al. discloses that filter queries can be used to pre-sort messages. Nowhere in this section, or elsewhere, however, does Birrell et al, disclose or suggest a message manager that includes a plurality of message components corresponding to elements of the message, where each of the message components is configured to recognize a specific, portion of the message and modify the specific portion based on the user Preferences, as recited in claim 4.

35. Examiner disagrees as the message manager inherently exists to provide oversight to recognize a "specific portion of the message," (i.e., body or header) wherein the elements are interpreted as the body and header of the e-mail message. Furthermore, the header portion contains addressing information, which is vital to ensure message delivery, and therefore requires certain components to deliver the message. Furthermore, user preferences are user to filter certain messages coming into users mailboxes.

36. The Examiner alleged that Birrell et al. discloses these features and cited column 9, lines 10-16, and Figure 7 of Birrell et al, for support (Office Action, pages 3-4). Applicants respectfully disagree.

37. Column 9, lines 10-16, of Birrell et al, is reproduced above. Nowhere in this section, or elsewhere, do Birrell et al. disclose or suggest a message manager that includes a header component configured to process a header portion of the message, a separator component configured to process a separator portion of the message, and a body component configured to process a body portion of the message, as recited in claim 5.

38. Examiner disagrees as Birrell et al. discloses in figure 7 & the citation of Column 9 Lines 10-16 including a header component, a body component and inherently a separator (line or module

used to separate body from header) component. Please review cited reference column and line numbers for clarification.

39. Nowhere in this section, or elsewhere, does Birrell et al. disclose or suggest a message manager that includes a header component configured to process a header portion of the message, a separator component configured to process a separator portion of the message, and a body component configured to process a body portion of the message, as recited in claim 5. For at least these additional reasons, Applicants submit that claim 5 is not anticipated by Birrell et al.

40. Examiner disagrees as Birrell et al. discloses in figure 7 & the citation of Column 9 Lines 10-16 including a header component, a body component and inherently a separator (line or module used to separate body from header) component. Please review cited reference column and line numbers for clarification.

41. For example, Birrell et al. does not disclose or suggest means for generating at least one event for triggering out-of-band processing of the processed message based on the user preferences. This feature is similar to a feature recited in claim 1. Claim 9 is, therefore, not anticipated by Birrell et al. for reasons similar to reasons given with regard to claim 1.

42. Examiner disagrees as Birrell teaches of triggering out-of-band processing of a message based on user preference for processing messages wherein out-of-band processing can be interpreted as any processing that is executed external to a system which is designed for example to send and receive messages. Specifically, the reference discloses a method for sending and receiving mail messages based on user preferences where the sending and receiving part is interpreted as an in-band processing and send the message to be printed is in contrast interpreted as an out-of-band processing. The Examiner asks the Applicants to pay close attention to column 9, lines 25-40 where the reference teaches of printing a message.

43. Birrell et al. also does not disclose or suggest means for performing out-of-band processing of the processed message in response to the at least one event to create an enhanced message, which is then provided for delivery to a message recipient, as further recited in amended claim 9. The Examiner alleged that Birrell et al. discloses performing out-of-band processing of messages (changing label state) in response to at least one event (outputting, displaying, or printing) (Office Action, page 3). Birrell et al. discloses that an unread label associated with a message is removed in response to the outputting, displaying, or printing of the message (col. 9, lines 25-27). The outputting, displaying, and printing of a message occurs after the message has been delivered to a message recipient and, therefore, cannot be equated to the out-of-band processing that occurs prior to delivery, as recited in claim 9.

44. Examiner disagrees as nowhere recited in the claims does the Applicant state that out-of-band processing occurs prior to delivery. Applicant needs to understand that examiner will review/reject/allow the claims in lite of the specification wherein the Applicant does not specifically describe IN THE CLAIMS that out-of-band processing occurs prior to delivery of the message. Furthermore, out-of-band processing is interpreted as being equated to a process executed outside the message delivery system and therefore Birrell teaches of triggering out-of-band processing of a message based on user preference for processing messages wherein out-of-band processing can be interpreted as any processing that is executed external to a system which is designed for example to send and receive messages. Specifically, the reference discloses a method for sending and receiving mail messages based on user preferences where the sending and receiving part is interpreted as an in-band processing and send the message to be printed is in contrast interpreted as an out-of-band processing. The Examiner asks the Applicants to pay close attention to column 9, lines 25-40 where the reference teaches of printing a message.

45. The Examiner alleged that the in-band processing corresponds to parsing in Birrell et al. and the out-of-band processing corresponds to removing an unread label in Birrell et al. (Office Action, pages 2-3). Applicants disagree.

46. Claim 22 further recites that the personal messaging agents perform the in-band and out-of-band processing of the message streams before the message streams are delivered to one or more mailboxes of one or more message recipients by the local delivery agent. The "removing an unread label" described by Birrell et al, occur g after the message is delivered to the message recipient (col. 9, lines 25-27). Therefore, removing an unread label cannot be equated to the out of-band processing recited in claim 22.

47. Examiner disagrees as Applicant may be confused as to what information the examiner is trying to convey. The Examiner, when citing the reference at column 9 lines 24-40 is trying to point towards the printing aspect of the cited reference, wherein the triggering of out-of-band processing of a message based on user preference for processing messages wherein out-of-band processing can be interpreted as any processing that is executed external to a system which is designed for example to send and receive messages. Specifically, the reference discloses a method for sending and receiving mail messages based on user preferences where the sending and receiving part is interpreted as an in-band processing and send the message to be printed is in contrast interpreted as an out-of-band processing. The Examiner asks the Applicants to pay close attention to column 9, lines 25-40 where the reference teaches of printing a message.

***Claim Rejections - 35 USC § 102***

48. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

h. A person shall be entitled to a patent unless –

i. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.



49. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

50. ***Claim(s) 31 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Walters et al. (US Patent Application Publication No. 2001/0052019 and Walters hereinafter).***

51. As per claim(s) 31 REF(A) discloses the in-band and out-of-band processing are performed in parallel and prior to providing the e-mail message for delivery to the e-mail recipient, (See Paragraph(s) 0014-0015).

#### ***Conclusion***

52. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

j. Kennedy et al. (US Patent No. 6,134,582) discloses a system and method for managing electronic mail messages using a client-based database;

k. Li et al. (US Patent No. 6,067,568) discloses an automatic setup of services for computer system users;

l. Wood et al. (US Patent Application Publication No. 202/0111991) discloses a message management system for handling personal messages from E-mail and voice-mail sources over the Internet; and

m. Ulrich et al. (US Patent No. 6,052,735) discloses electronic mail object synchronization between a desktop computer and a mobile device;

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajid A Yussuf whose telephone number is (703) 305-8752. The examiner can normally be reached on Monday-Thursday 7:30-5:00 PM and Alternate Fridays.

54. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

55. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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